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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,229	06/28/2007	Elizabeth Rajan	14283.0013USWO	6747
23552 7590 12/05/2008 MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				
EXAMINER				
TREYGER, ILYA Y				
ART UNIT		PAPER NUMBER		
3761				
MAIL DATE		DELIVERY MODE		
12/05/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,229

Applicant(s)

RAJAN ET AL.

Examiner

ILYA Y. TREYGER

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/02)
- Paper No(s)/Mail Date 08/21/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-9 of the US Patent Application No. 10/590,229 filed 06/28/2007 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Rockey (US 4,763,653).

4. In Re claim 1, Rockey discloses a sleeve unit insertable in a natural body vessel (Abstract, lines 2, 3) capable of being used as a gastro-intestinal device (Col. 2, lines6-8), comprising:

a sleeve 51 (Fig. 9) that is a gastric bypass having an inlet A (Fig. 9) and outlet B (Fig. 9); and

an expandable inflatable balloon 50 (Fig. 9) attached to the gastric bypass (Col. 5, lines 64-68).

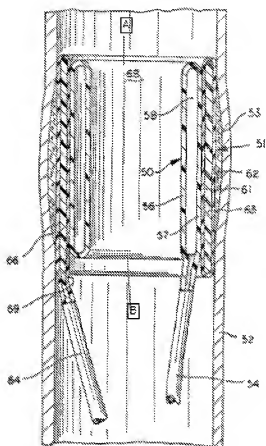


FIG.9

5. In Re claims 2 and 8, Rocky discloses the gastric bypass comprising the flaccid gastric bag, since the sleeve (sheath) is disclosed as formed of flexible material (Col. 3, line 33).
6. In Re claim 7, Stack discloses an implantable satiety device (page 1, [0005], lines 1-4) that is a gastro-intestinal device, comprising:
- a tube 10c (Fig. 13) that is a gastric bypass having an inlet A (Fig. 13) and outlet B (Fig. 13); and

7. Rockey discloses a sleeve unit insertable in a natural body vessel (Abstract, lines 2, 3) capable of being used as a gastro-intestinal device (Col. 2, lines 6-8), comprising:

a sleeve 51 (Fig. 9) that is a gastric bypass having an inlet A (Fig. 13) and outlet B (Fig. 9); and

an expandable toroidal inflatable balloon 50 (Fig. 9) attached to the gastric bypass (Col. 5, lines 64-68), and wherein the expandable chamber is asymmetric (claim 9).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rockey (US 4,763,653

12. Rockey discloses an implantable satiation device (page 1, [0005], lines 1-4) that is a gastro-intestinal device, comprising:

a tube 10c (Fig. 13) that is a gastric bypass having an inlet A (Fig. 13) and outlet B (Fig. 13); and

an expandable inflatable reservoir 54 (Fig. 13) attached to the gastric bypass (See page 4, [0059] and [0060]).

Rockey does not expressly disclose the device wherein the expandable chamber is made in form of plurality of adjacent subchambers.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the expandable chamber in form of plurality of adjacent subchambers such as a quasi-geodesic pattern (claim 6) in order to increase the square area of the chamber, since it has been held that mere multiplication of the essential working parts of a device involves only routine skill in the art.

13. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rockey (US 4,763,653) in view of Stack et al. (US 2003/0199991).

14. In Re claim 3, Rockey discloses the invention discussed above, but does not expressly disclose the device having ribs facilitating collapse of the tube in the absence of compressive forces.

Stack teaches the gastric bypass comprising radially extending tabs 13 (Fig. 16B) that are ribs facilitating collapse of the tube in the absence of compressive forces (page 3, [0045], lines 1-6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Rockey with the tabs, as taught by Stack in order to facilitate collapse of the tube (page 3, [0045], line 2).

15. In Re claim 4, Rockey discloses the invention discussed above, but does not expressly disclose the device formed of a polymeric sleeve with nitinol struts embedded in the sleeve material.

Stack teaches the device formed of a polymeric sleeve with nitinol struts embedded in the sleeve material (See page 4, [0060], lines 8-10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Rockey with the nitinol struts, as taught by Stack in order to provide the device with the additional rigidity.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILYA Y. TREYGER whose telephone number is (571)270-3217. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ilya Y Treyger/
Examiner, Art Unit 3761

/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit 3761